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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/555,280

12/06/2005

Franz Wombacher

125239

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25944 7590 06/11/2009

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/555,280	Applicant(s) WOMBACHER ET AL.	
	Examiner Paul Marcantoni	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/2/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election with traverse of Group I in the reply filed on 5/4/09 is respectfully acknowledged. The traversal is on the ground(s) that the search would overlap and without serious burden. This is not found persuasive because the examiner has shown his restriction proper in accordance with Rule 13.2 and the Group I (claim 8) invention was found to provide no special technical contribution over the prior art. Applicants did not traverse the prior art cited which is how they must traverse this type of restriction requirement. The serious burden is met based on the proper 371 PCT type restriction. There is a serious burden on the examiner to examine all claims. If applicants wish to state for the record (and they need to do so if the restriction would be withdrawn) that all groups of invention are *obvious variants*, then they should now state this now for the record. He will then withdraw the restriction. This should not be a serious burden on applicants end to do so. It should be noted that it also advantageous for applicants to state they are obvious variants since they argue that they wish to avoid duplicative expenses. This seems to imply they do agree that the groups of inventions are obvious variants. The duplicative expenses and undue expenses on applicants end can be avoided easily by admitting the groups of invention are obvious variants for the record. No duplication would thus be needed and the cost savings are evident. If they agree to state this, please note that if the examiner finds any one of the Groups of restricted inventions he has found them all since applicants' admission will be used against them in a rejection. It might be a risk not worth taking since one Group of Invention may be potentially allowable while another is not. The requirement is still deemed proper and is therefore made FINAL.

35 USC 102/103:

Claims 8-14 are rejected under 35 USC 102(b) as anticipated, or in the alternative, as obvious over Walter (US 2,574,516-see also answer 37 of 37 in search abstract), Blum et al. (DE 1099257 or GB 895628 abstract-answer 33 or 37), Von Bonin et al. (DE 3530358 abstract-answer 11 of 37), or Rosenfeld (Answer 13 of 37-Russian Article abstract-"Study of mechanism of hydrogen sulfide corrosion...").

All of the above cited abstract references teach a composition that anticipates the general formula (I) for applicants' claim 8. Even if not anticipated, the references above teach the same range of amounts for values such as n, m+K, m, k, etc. Please refer to the structures described in each abstract and it will be readily seen that the structure of (I) is within the teaching of this prior art. Note also that Answer 37 of 37 (Walter US '516) even teaches Formula (II) in the abstract. Also note that the examiner used the same rejection in the restriction requirement and that this was found to be the best available prior art for the elected invention.

It is noted that the examiner submitted his search through the USPTO STIC (Scientific Technical Information Center) and he has taken full faith in credit in the abilities of these technical searching experts in obtaining the best available prior art for the elected invention. They specifically discussed which art represents the best available prior art as well. This search strategy and printout can be seen in Electronic Pair or EDAN under date 1/7/2009 which contains 92 pages of the search results.

Art Unit: 1793

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793